UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,238	02/07/2000	Gregory A. Stobbs		9957

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EXAMINER
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2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/499,238	STOBBS ET AL.
	Examiner	Art Unit	
	LESLIE WONG	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>15 June 2007</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-7,11-22,31 and 32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-7,11-22,31 and 32</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>2/7/2000</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

2.   Claims 1-7, 11-16, 18-22, and 31-32 are rejected under 35 U.S.C. 103(a) as

being unpatentable over **Snyder et al. ("Snyder")** (U.S. Patent 6,038,561) in view of

Risen, Jr. et al. ("Risen") (U.S. Patent 6,018,714) and **Petruzzi et al. ("Petruzzi")** (U.S.

Patent 6049811 A).

Regarding claim 1, **Snyder** teaches a computer implemented patent portfolio

analysis method comprising:

a).   retrieving a corpus of patent information from a database, said information

including multiple claims from a plurality of patent documents (col. 4, lines 3-7 and lines

8-18);

Snyder further teaches analysis of structured documents such as claims within

patents, accurately compare claims from two different patents in attempt to identify both

the scope and references of the claims. Additionally, the system translate a set of

claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr"

file. This file consists of a list of each unique term in the original claimlist files followed

by a count of the number of occurrences of that term for each document (col. 11, lines

22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically determining claim breadth metrics for the multiple claims by

using computer to measure claim length;

c).   associating a claim breadth metric with a claim and storing said

associated claim breadth metric in a computer-readable dataset; and

d).   wherein a claim breadth metric which is associated with a claim is

indicative of how broad the claim is.

Risen, however, teaches the steps of:

b).   determining claim breadth metrics for the multiple claims as valuation of

the intellectual property asset is the assignment of a monetary value to the intellectual

property asset. This value can be based upon the income and profits generated by the

sale or use of the patented technology, the number of remaining on the term of the

patent, *the breadth of the claims*, the nature of the patented technology, the nature of

competitive products or processes etc. (col. 9, lines 20-29);

c).   associating a claim breadth metric with a claim and storing said

associated claim breadth metric in a computer-readable dataset (col. 9, lines 29); and

d).   wherein a claim breadth metric which is associated with a claim is

indicative of how broad the claim is (col. 9, lines 29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Risen-**

Snyder's to provide the breadth metrics as a means for users to quickly identify the

scope of the claimed subject matter together with other value asset factors in order to

determine the suitable premium for insuring the intellectual property asset or assets as

suggested by **Risen** at col. 9, lines 44-56.

Snyder and Risen do not explicitly teach the step of:

b).   automatically determining claim breadth and using computer to measure

claim length.

Petruzzi, however, teaches "automatically" and "using computer to measure

claim length" as the computer counts the number of words in the drafting area 290 of

the Abstract 110 and reminds the operator if there appears more than a set amount,

e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum

has been exceeded, the operator will be prompted to remove words from the drafting area ... removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

The applied prior arts do not explicitly teach the concept of "determining the claim breadth by measuring claim length".

However, Official Notice is given that counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as the longer the length of the claim, normally, the narrower the scope of the claim and vice versa.

Regarding claims 2 and 12, **Snyder** further teaches a step of counting the number of words in the claim text for each of said multiple claims (col. 14, lines 36-59).

Snyder does not explicitly teach determining claim breadth metrics and generating claim breadth metrics for the multiple claims therefrom.

Risen, however, teaches the step of determining claim breadth metrics and generating claim breadth metrics for the multiple claims therefrom as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, *the breadth of the claims*, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

Snyder and Risen do not explicitly teach automatically counting the number of words in the claim text.

Petruzzi, however, teaches "automatically" and "using computer to measure claim length" as the computer counts the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area ... removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

Regarding claims 3 and 13, **Snyder** does not explicitly teaches a step wherein said step of automatically determining claim breadth metrics includes automatically identifying within the claim text for each of said multiple claims a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said count to generate a claim breadth metric for each of said multiple claims.

Risen, however, teaches the step of determining claim breadth metrics and generating claim breadth metrics for the multiple claims therefrom as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, *the breadth of the claims*, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

Snyder and Risen do not explicitly teach automatically determining claim breadth metrics.

Petruzzi, however, teaches "automatically determining claim breadth metrics" as the computer counts the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum has been

exceeded, the operator will be prompted to remove words from the drafting area ...

removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and effective way

to complete a task. Further, it should be noticed that counting the number of words in

said preamble and body portions and applying separate weights to said count to

generate said claim breadth metric is well-known in the field of Patent claim drafting. In

this present case, the ordinary skill in the art would have known that the breadth of a

claim is inversely proportional to the quantity of limitations recited therein.

Regarding claims 4, 14, and 18, **Snyder** further teaches a step of determining

claim breadth metrics includes parsing the claim text for each of said multiple claims to

identify parts of speech (col. 13, lines 33-34), using said identified parts of speech to

identify clauses within each of said multiple claims, comparing said clauses with the text

of other claims in said corpus to generate scores indicative of which clauses within said

claim text have a lower probability of being found in other claims within said corpus (col.

3, lines 50-58; col. 4, lines 8-18; col. 17, line 65 – col. 18, line 17).

Snyder and Risen do not explicitly teach automatically.

Petruzzi, however, teaches "automatically" and "using computer to measure claim length" as the computer counts the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area ... removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

Regarding claims 5 and 15, **Snyder** further teaches a step of displaying said patent information in a sorted order (col. 27, lines 32-36).

Snyder does not explicitly teach display patent information based on claim breadth metric.

Risen, however, teaches the step of valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

Regarding claim 6, **Snyder** further teaches a step of determining claim breadth

metrics includes linguistically processing the claim text for each of said multiple claims

to identify at least one clause within said claim text that has a lower probability than

other of said clauses within said claim text of being found in other claims within said

corpus (col. 3, lines 29-31; col. 4, lines 49-62; and col. 25, lines 7-25).

Snyder and **Risen** do not explicitly teach automatically.

Petruzzi, however, teaches "automatically" and "using computer to measure

claim length" as the computer counts the number of words in the drafting area 290 of

the Abstract 110 and reminds the operator if there appears more than a set amount,

e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum

has been exceeded, the operator will be prompted to remove words from the drafting

area ... removing some of the limitations appearing in the dependent claims (col. 14,

lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and effective way

to complete a task.

Regarding claims 7 and 19, **Snyder** further teaches a step of displaying said

claim text such that said one clause is visually presented differently than the other of

said clauses (col. 4, lines 12-16).

Regarding claim 11, **Snyder** teaches a computer-implemented patent portforlio

analysis method comprising:

a).   retrieving text of multiple claims from a computer-implemented data store,

wherein the text of claims are from a plurality of patent documents (col. 4, lines 3-7 and

lines 8-18);

Snyder further teaches analysis of structured documents such as claims within

patents, accurately compare claims from two different patents in attempt to identify both

the scope and references of the claims. Additionally, the system translate a set of

claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr"

file. This file consists of a list of each unique term in the original claimlist files followed

by a count of the number of occurrences of that term for each document (col. 11, lines

22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically analyzing said retrieved text to identify the independent

claims;

c).   automatically analyzing the text of the independent claims in order to

generate claim breadth metrics for the independent claims, wherein a claim breadth

metric that is associated with a claim is indicative of how broad the claim is.

d).   wherein the claim breadth metrics are used to analyze the multiple claims.

Risen, however, teaches as valuation of the intellectual property asset is the

assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Snyder's** to

provide the breadth and the scope of the claimed subject matter together with other

value asset factors in order to determine the suitable premium for insuring the

intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Snyder and Risen do not explicitly teach the steps of:

b).   automatically analyzing said retrieved text to identify the independent

claims.

    c).   automatically.

    Petruzzi, however, teaches "automatically analyzing said retrieved text to identify the independent claims" as the computer counts the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area ... removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

    It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

    The applied prior arts do not explicitly teach the concept of "determining the claim breadth by measuring claim length".

    However, Official Notice is given that counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as

the longer the length of the claim, normally, the narrower the scope of the claim and

vice versa.

Regarding claim 16, **Snyder** further teaches a step wherein the sorted patent

documents are used in a patent infringement study (col. 4, lines 8-18).

Regarding claim 20, **Snyder** further teaches a step wherein the generated

descriptive statistics are indicative of quality of claims analyzed (col. 24, lines 4-20).

Snyder does not explicitly teach generating descriptive statistics based upon the

generated claim breadth metrics.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, ***the breadth of the***

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

Regarding claim 21, **Snyder et al.** further teaches a step wherein generated

descriptive statistics are generated for groupings of claims (col. 24, lines 34-39).

Regarding claim 22, **Snyder** further teaches a step wherein the claim groupings

are formed based upon patent ownership, wherein the generated descriptive statistics

are statistics selected from the group consisting of average, average of the averages,

standard deviation, maximum, minimum, and combinations thereof (Fig. 8D).

Regarding claim 31, **Snyder** teaches a computer-implemented patent portfolio

analysis apparatus comprising:

a).   a database of patent documents containing text of claims (col. 4, lines 3-

7);

c).   a cluster generator that analyzes patent information to generate category

metrics for the patent documents, wherein clusters of patent documents are determined

based upon the generated category metrics (col. 23, lines 10-41 and col. 24, lines 49-

62), wherein the clusters of patent documents are provided over an internet network for

use in analyzing the patent documents (col. 25, lines 40-58).

b).   **Snyder** does not explicitly teach a claim breadth analysis module that

analyzes the text of the claims in order to generate claim breadth metrics for the claims,

wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the

claim breadth metrics are provided over an internet network for use in analyzing scope

of the claims.

Risen, however, teaches the step b as valuation of the intellectual property asset

is the assignment of a monetary value to the intellectual property asset. This value can

be based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, *the breadth of the*

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Snyder's** to

provide the breadth and the scope of the claimed subject matter together with other

value asset factors in order to determine the suitable premium for insuring the

intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Risen and **Snyder** do not explicitly teach "automatically analyzes the text".

Petruzzi, however, teaches "automatically" as the computer counts the number

of words in the drafting area 290 of the Abstract 110 and reminds the operator if there

appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250

words is preferred... if the maximum has been exceeded, the operator will be prompted

to remove words from the drafting area ... removing some of the limitations appearing in

the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

The applied prior arts do not explicitly teach the concept of "determining the claim breadth by measuring claim length". ·

However, Official Notice is given that counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as the longer the length of the claim, normally, the narrower the scope of the claim and vice versa.

Regarding claim 32, **Snyder** a computer-implemented patent portfolio analysis method comprising:

a).   retrieving a corpus of patent information from a database, said patent information including the claim text of a plurality of claims (col. 4, lines 3-7 and lines 8-18);

Snyder further teaches analysis of structured documents such as claims within patents, accurately compare claims from two different patents in attempt to identify both the scope and references of the claims. Additionally, the system translate a set of claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr" file. This file consists of a list of each unique term in the original claimlist files followed by a count of the number of occurrences of that term for each document (col. 11, lines 22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically analyzing the claim text of said plurality of claims to

generate and associate an individual claim breadth metric with each of said plurality of

claims.

Risen, however, teaches the step of analyzing the claim text of said plurality of

claims to generate and associate an individual claim breadth metric with each of said

plurality of claims as valuation of the intellectual property asset is the assignment of a

monetary value to the intellectual property asset. This value can be based upon the

income and profits generated by the sale or use of the patented technology, the number

of remaining on the term of the patent, *the breadth of the claims*, the nature of the

patented technology, the nature of competitive products or processes etc. (col. 9, lines

20-29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Snyder's** to

provide the breadth and the scope of the claimed subject matter together with other

value asset factors in order to determine the suitable premium for insuring the

intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Snyder and **Risen** do not explicitly teach <u>automatically</u> analyzing the claim text.

Petruzzi, however, teaches "automatically analyzing the claim text" as the computer counts the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred... if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area ... removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

The applied prior arts do not explicitly teach the concept of "determining the claim breadth by measuring claim length".

However, Official Notice is given that counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as the longer the length of the claim, normally, the narrower the scope of the claim and vice versa.

3.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder**

et al. (**"Snyder"**)(U.S. Patent 6,038,561) in view of **Risen, Jr. et al.** (**"Risen"**) (U.S.

Patent 6,018,714) and **Petruzzi et al.** (**"Petruzzi"**) (U.S. Patent 6049811 A) as applied

to claims 1-7, 11-16, 18-22, and 31-32 above and in view of **Rivette et al.**

(**"Rivette"**)(U.S. Patent 6,339,767 B1).

Regarding claim 17, **Snyder, Risen,** and **Petruzzi** do not explicitly teach a step

wherein the sorted patent documents are used to determine patent documents whose

maintenance fees are not to be paid.

Rivette, however, teaches a step wherein the Financial Modules perform patent-

centric and group-oriented processing of the data in the financial database. Examples

of the functions performed by the financial modules include determining the research

and design expenditures, determining maintenance fees, and determining cumulative

product revenue on a product or product line basis, etc. (col. 94, lines 23-43).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Rivette's**

teaching would have allowed **Snyder- Risen's** to project various types of costs on

certain products or licensing revenue associated with any patent own by the company at

suggested by **Rivette** at col. 94, lines 62-64.

Response to Arguments

Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE WONG whose telephone number is (571)272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571)272-4085. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

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